

REMARKS**I. PRELIMINARY REMARKS**

A minor amendment has been made to the specification.¹ No claims have been amended, added or canceled. Claims 1-16, 18-20, and 22-29 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

Applicant notes with appreciation that claims 1-10, 16, 18-20 and 22-29 have been allowed.

II. PRIOR ART REJECTIONS OF CLAIMS 11-15**A. The Rejections**

Claims 11 and 13-15 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of U.S. Patent No. 5,904,652 to Gilbert ("the Gilbert patent") and U.S. Patent No. 6,575,167 to McFadden ("the McFadden patent"). Claim 12 has been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Gilbert patent, the McFadden patent and U.S. Patent No. 6,263,381 to Freadman ("the Freadman patent"). The rejections under 35 U.S.C. § 103 are respectfully traversed. Reconsideration thereof is respectfully requested.

B. Discussion

Independent claim 11 calls for a combination of elements comprising "a main housing," "a keyboard and a display associated with the main housing" and "a handle associated with the main housing and including a data connector and a

¹ The amendment to the specification merely corrects a minor typographical error. Applicant respectfully submits such an amendment does not raise new issues and should be entered for purposes of appeal in accordance with 37 C.F.R. § 1.116(a) and MPEP 714.12 and 714.13.

mechanical connector." The respective combinations defined by claims 12-15 include, *inter alia*, the elements recited in claim 11. Applicant respectfully submits that the cited references fail to teach or suggest such combinations.

For example, the Gilbert patent discloses an ultrasound imaging system 10 including a hand-held scan head 12 with a transducer section 15A and a handle section 15B. The scan head 12 is connected to a laptop computer 14 (with a keyboard) by a cable 16. Even assuming for the sake of argument that the scan head handle section 15B is "associated with" the same housing as keyboard, the Gilbert scan head handle section does not include a "mechanical connector," as called for in the combination defined by independent claim 11.

The Office Action attempts to remedy the aforementioned deficiencies in the Gilbert patent with the teachings of the McFadden patent. The McFadden patent is directed to a protection device (i.e. a shield) that may be used in combination with "hand held imaging devices **with a needle guide** for biopsy/aspiration positioning." [Column 1, lines 6-14.] The sole purpose of the shield is to **protect the physician from being stuck by a needle**. [Note, for example, the Title; the Abstract; column 1, lines 15-36; column 1, line 53 to column 2, line 18; and column 2, lines 21-37 and 45-53.] Given the fact that the Gilbert scan head 12 does not include a needle (or anything else from which the physician might need protection), there is absolutely no reason to add the McFadden protection device to the Gilbert scan head other than a hindsight attempt to replicate the claimed combinations.²

As the Gilbert and McFadden patents fail to teach or suggest the combination of elements recited in independent claim 11, applicant respectfully submits that the rejection of claims 11 and 13-15 under 35 U.S.C. § 103 is improper and should be withdrawn.

Turning to the rejection of claim 12 under 35 U.S.C. § 103, applicant respectfully submits that the Freadman patent fails to remedy the aforementioned

² As the Federal Circuit reiterated in *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), "a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding.'" [Citations omitted.] The burden of showing obviousness may be satisfied "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." [Id. at 1434, citations omitted.]

deficiencies in the Gilbert and McFadden patents. As such, for reasons in addition to those discussed above, the rejection of claim 12 under 35 U.S.C. § 103 should also be withdrawn.

III. CLOSING REMARKS

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 08-2025. Should such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

4 / 20 / 01
Date

Respectfully submitted,


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